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10/567,478

06/26/2006

Marcus Nystrom

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EXAMINER

MICHALSKI, SEAN M

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

09/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/567,478 | Applicant(s) NYSTROM, MARCUS | |
| | Examiner SEAN M. MICHALSKI | Art Unit 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/07/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 3-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/30/2008.

Applicant has argued that the restriction is improper because the “Restriction is between groups that are not mutually exclusive.” This is not a requirement for a proper restriction in a 371 case. The proper showing is that the different groups each possess a special technical feature that makes them not relate to a single general inventive concept. In this case the groups, which relate to dependent claims, are *divergent* in the subject matter which they recite. They are directed to apparatuses requiring different components relative to one another, Meaning each group is patentably distinct over each other group—they could, in other words, each sustain a separate patent, if each special technical feature were found to be patentable. They are clearly distinct from one another, each group possessing a special technical feature that could establish patentability.

Applicant further argues that he is entitled to “a reasonable number of claims”, and further postulates that “Eleven claims is well within a reasonable limit, since it is well below the number twenty which is permitted within an application without any further surcharge...”. Eleven claims would indeed be reasonable if each claim was directed to the same invention, not five patentably distinct inventions.

The fee structure of the USPTO is irrelevant in determining a reasonable number of claims for restriction purpose. The test for a proper restriction in a 371 case, as has already been set forth is whether each group has a special technical feature, which has not been disputed.

Information Disclosure Statement

2. The information disclosure statement filed 02/07/2008 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “locking device that secures one end of the cutting filaments to the bobbin” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The "locking device that secures one end of the cutting filaments to the bobbin" is not shown in the figures. It is entirely unclear how one of ordinary skill would be capable of making and using a locking device in accordance with this claim, since no such locking device is described, or depicted. Only the function of the element has been described, but not any aspect of its structure. One of ordinary skill in the art would be unable to

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make and use the device having a "locking device that secures one end of the cutting filaments to the bobbin".

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation that the "opening is extending in axial direction (sic) of the trimmer head", Which is unclear based on the specification and the drawings which show an opening extending in a radial direction through the trimmer head, and also extends in the circumferential and axial directions in a "check" or "V" shape. It is unclear whether or not "extending in axial direction(sic)" should be taken to mean having a component of the opening with extends in the axial direction. Clarification on this point is requested.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United states.

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9. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugihara (US 5,522,141).

Sugihara discloses a trimmer head (figure 65, at least) comprising at least two eyelets (10 figure 65) and a bobbin (8 figure 65) with at least two sections (clearly shown in figures 2, 10 and 65, at least) for storing of one cutting filament (11) in each section (see figure 2; column 14 line 5 "cords") said eyelet (10, figure 65) is placed in a housing (4 figure 65) surrounding the bobbin, characterized in that the eyelet (10) is provided with an opening (see figures 2 and 10) for the cutting filament, said opening is extending in axial direction of the trimmer head (the opening is a three dimensional void, which extends in all three dimensions, axial, radial, and bi-normal to those defined axes) so that the opening provides access to all sections (see figures 2, 10 and 65; each eyelet is symmetrical, and disposed symmetrically relative to each of the two storage sections) for storing of cutting filaments and that one side of the opening (the opening is circular) has a groove (an arcuate portion of the circular opening constitutes a groove) shaped so that the cutting filament (11) is placed in the groove when the trimmer head rotates in the intended direction (when the rotary cutter rotates, the filament will be pushed to one lateral side of the circular opening, this arcuate portion thereof constituting a groove) so that the cutting filament is placed in the groove by the forces generated by the rotation no matter of which section of the bobbin the filament is stored in (this is clear because of the symmetry of the two openings, and their relative symmetry with both the upper and lower sections of the bobbin--in other words it is clear that the filament shown running from the top section to one opening could be just as

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easily pulled from the lower section, and vice versa, since the entire arrangement is clearly symmetrical).

Regarding claim 2, Sugihara discloses that the eyelets (10) are placed around the same axial position on the trimmer head housing so that the cutting filaments will rotate in the same plane around the trimmer head (see at least figures 2, 10 and 65).

Regarding claim 3, Sugihara discloses a fragment of wall, as clearly seen in figures 2, 10 and 65.

Regarding claim 4 there is inherently a locking device for securing each filament within it's respective section. Otherwise the filaments would fly out and not work.

Regarding claims 5 and 6 Sugihara clearly discloses two eyelets and two filaments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN M. MICHALSKI whose telephone number is (571)272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sean M Michalski/
Examiner, Art Unit 3724

/Kenneth Peterson/
Primary Examiner, Art Unit 3724